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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,135	09/22/2003	Quin Winford	A04027US (98885.1)	8412
22920	7590	06/01/2005	EXAMINER	
GARVEY SMITH NEHRBASS & DOODY, LLC THREE LAKEWAY CENTER 3838 NORTH CAUSEWAY BLVD., SUITE 3290 METAIRIE, LA 70002			STASHICK, ANTHONY D	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/666,135

Applicant(s)

WINFORD ET AL.

Examiner

Anthony Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-15 is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7,16 and 18-20 is/are rejected.
- 7) ☒ Claim(s) 3,8 and 17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 18 contains the phrase "said carrying case" in line 1-2 of the claims. There is insufficient antecedent basis for this limitation in the claim.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. Claims 1, 2, 4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Chen et al. 6,354,609. Chen et al. '609 discloses all the limitations of the claims including the following: right and left shoe members each having a sole (see Figures, left and right shoes in "pair of skates"); each sole having front and rear rotating discs 20 coupled along a lateral side of the sole

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(see Figure 2); the front and rear rotating discs provide an appearance of rotating wheels when rotating (wheels 20 look like spoke wheels of an automobile); the right and left shoe members provide an illusion of a vehicle (wheels 20 look like spoke wheels of an automobile); front and rear rotating discs provide the appearance of rotating wheels rotating (when wheels 20 rotate, they appear like wheels rotating); the front rotatable disc is the same size as the rear rotatable disc (See Figure 2); the right and left shoe members are sneakers (see Figure 20).

5. Claims 1, 2, 4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Hernandez 2004/0036237. Hernandez '237 discloses all the limitations of the claims including the following: right and left shoe members each having a sole (applicant mentions use for shoes or skates meaning more than one or one for each foot); each sole having front and rear rotating discs 34, 42 coupled along a lateral side of the sole; the front and rear rotating discs provide an appearance of rotating wheels when rotating (wheels look like wheels of an automobile); the right and left shoe members provide an illusion of a vehicle (wheels look like wheels of an automobile); front and rear rotating discs provide the appearance of rotating wheels rotating (front and rear wheels look like wheels when rotating); the front rotatable disc is the same size as the rear rotatable disc (see Figure 1); the right and left shoe members are sneakers (see Figure 1).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being obvious over either of the references as applied to claim 1 above. Each of the references as applied to claim 1 above disclose wheels attached to the side of the sole of a sneaker. Whether the front wheel and the rear wheel are the same size would depend upon the desired look and performance of the skate shoe and therefore, it would have been a mere matter of design choice to make the front wheel smaller than the rear to give the impression of a “low riding” skate shoe.

8. Claims 16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hernandez 2004/0036237 or Chen et al. 6,354,609 (as applied above) in view of Vass 1,672,700. Hernandez ‘237 and Chen et al. ‘609 as applied above disclose all the limitations of the claims except for the remote controller for controlling the front and rear rotating discs. Vass ‘700 teaches that a remote control 27 can be used to control the speed of the wheels of a skate. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place a remote controller, such as that shown in Vass ‘700, on the skate shoe of Hernandez ‘237 or Chen et al. ‘609, as applied above, to aid in controlling the speed of the wheels of the skate shoes.

9. Claims 7 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1 and 16 above in view of Moumdjian 5,295,314. The references as applied to claims 1 and 16 above disclose all the limitations of the claims except for the sole having an inflatable chamber a pump and a port for filling the chamber. Moumdjian ‘314 teaches that the sole of a shoe can have an inflatable chamber 6 that is inflated through a port 8, which allows for pumping of air into the chamber (See col. 3, lines 1-11). This chamber allows the user to adjust the comfort of the shoe on the user’s foot to the user’s desirability. Therefore,

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it would have been obvious to place an inflatable chamber, with a filling port and pump, in the sole of the references as applied to claims 1 and 16 above, to be able to adjust the comfort of the skate on individuals user's of the skate.

*Allowable Subject Matter*

10. Claims 38, 17 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. With respect to claim 18, it would also have to be amended to over come the 35 USC 112, second paragraph problems noted above.

*Conclusion*

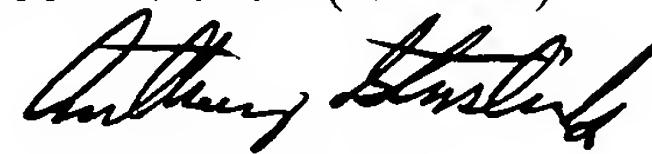
11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and are cited on form 892 enclosed herewith.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday-Thursday 8:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony Stashick  
Primary Examiner  
Art Unit 3728

ADS